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REMARKS

Upon entry of the present amendment, previously pending claims 12-18 will not have been amended. However, new claims 19-27 will have been submitted for consideration by the Examiner. These claims are being submitted to afford Applicants the scope of coverage to which they are entitled.

In view of the herein contained remarks, Applicants' respectfully request reconsideration and withdrawal of each of the outstanding rejections set forth in the Official Action of January 14, 2008, together with an indication of the allowability of all of the claims pending in the present application, in due course. Such action is believed to be appropriate and proper and is thus respectfully requested.

In the outstanding Official Action, the Examiner rejected claims 12 and 15-17 under 35 U.S.C. § 102 (e) as being anticipated by HUNA (U.S. Patent No. 6,438,217). The Examiner additionally rejected claims 13 and 18 under 35 U.S.C. § 103 (a) as being unpatentable over HUNA in view of RANALLI et al. (U.S. Patent No. 6,748,057). Claim 14 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over HUNA in view of GOODMAN (U.S. Patent No. 6,735,617).

Applicants' respectfully traverse the above noted rejections and submit that they are inappropriate with respect to the combination of features recited in Applicants' claims. In particular, Applicants' respectfully submit that the combinations of features recited in each of Applicants' independent claims are clearly patentable over the disclosures of the references cited by the Examiner, whether considered individually or

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whether considered in any proper combination, whether considered under 35 U.S.C. § 102 or even if considered under 35 U.S.C. § 103.

Accordingly, Applicants respectfully request reconsideration of each of the outstanding rejections together with an indication of the allowability of all of the claims pending in the present application, in due course.

Applicants' invention is directed to a server apparatus as defined by the combination of features recited in claim 12, to a communication system as defined by the combination of features recited in claim 16, and to a method for controlling an e-mail transmission as defined by the combination of features recited in claim 17. Utilizing the server apparatus as defined in claim 12 as a non-limiting example of Applicants' invention, the present invention is directed to a server apparatus that is connected to a transmitting IP apparatus, the transmitting IP apparatus transmitting an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus includes a memory configured to store an IP address of the receiving IP apparatus in association with a telephone number of the receiving IP apparatus, the IP address of the receiving IP apparatus being distinct from an e-mail address. A receiver is configured to receive the e-mail from the transmitting IP apparatus, the e-mail including the telephone number of the receiving IP apparatus. An analyzer is configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address, being the same as the receiving IP apparatus of the telephone number. Further, a transmitter is configured to

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transmit the received e-mail to the receiving IP apparatus of the telephone number, based on the stored IP address of the receiving IP apparatus.

The combination of features recited in Applicants' claims are not disclosed, taught, suggested or rendered obvious by HUNA or any proper modification thereof or in view of any of the secondary references relied upon by the Examiner.

HUNA relates to an apparatus and a method for transmitting a message, at a future delivery time, to a receiving device that is coupled either to a telephony-centric network or to a data-centric network. In figure 5 of HUNA, for those receiving devices 532 that are their connected to a data-centric network, the message server 402 (514) translates the message into a format compatible with the receiving device 532 and initiates delivery of the message. On the other hand, for those receiving devices 520, 524, 528, that are connected to a telephony-centric network, the message server 402 (514) embeds a telephone number of the receiving device 520, 524, 528 into the message. The IP address of "the local POP" 408 (516), which is not an IP address of the receiving device 520, 524, and 528, corresponding to the embedded telephone number of the receiving device, is obtained and the message is routed to the IP address of the local POP 408 (516), as explicitly set forth at column 15, lines 52 through 60 and column 16, lines 53 through 58.

According to the teachings of HUNA, for receivers connected to a telephony centric network, the IP address of a local POP in New York, San Jose, or Paris is used as an address for the respective messages and the respective local POP intercepts the message and directs the local call switches to contact either a pager, a fax machine, or a telephone using the embedded telephone number. In this regard, the Examiner's attention

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is respectfully directed to column 16, lines 46 through 51 and column 17, lines 39 through 42.

HUNA however does not disclose at least that the message server 402 (514) obtains, from a received e-mail, the telephone number of a receiving IP address, and obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number, as recited.

In setting forth the rejection, the Examiner asserts that HUNA discloses a memory as recited in claim 12. In support of this assertion, the Examiner noted the address book stored in the memory of the server of HUNA and directed Applicants attention to column 15, lines 13 through 21 and 46 through 48. However, there is no indication within the HUNA disclosure that the memory of the server stores an IP address in association with a telephone number of a receiving IP apparatus. In this regard, Applicants respectfully note that neither of the portions of column 15 relied upon by the Examiner in any manner support his position. While HUNA discloses the address book, he merely describes the same as enabling a recipient to be aliased to several receiving addresses to include a telephone number, a pager number, a fax number and e-mail address. Notably, there is no mention whatsoever of an IP address.

At line 46, HUNA discloses that the message server routes messages designated for receiving devices connected to the data-centric network 406 directly to the IP address of a recipient. Thus, when utilizing a data-centric network, the message server 402 (514) does not embed a telephone number of the receiving device (e.g. 532) into the message, since no telephone number is necessary when a data centric network is being utilized.

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This portion of HUNA again contains no disclosure regarding a memory that stores an IP address of a receiving IP apparatus in association with a telephone number of the receiving IP apparatus. On the contrary, this portion of the disclosure merely indicates that the server routes messages "directly" to IP address of a recipient. Presumably in such situations the IP address would be directly input, because in such situations there is no need whatsoever for a telephone number, in stark contrast to the recitations of Applicants claims.

The Examiner is also inaccurate and incorrect in addressing the recitation of Applicants' claims that "the IP address of the receiving IP apparatus being distinct from an e-mail address". The Examiner makes reference to figure 7 and indicates that the "TO:" field which indicates Richard's telephone number is distinct from Richard's IP address. However, Applicants' claim does not require the telephone number to be distinct from the IP address but rather that the IP address be distinct from an e-mail address.

In this regard Figure 7 merely discloses a telephone number within a recipient field 712. Figure 7 contains no disclosure regarding whether an e-mail address is distinct from an IP address of a receiving IP apparatus, which is what Applicants' claim requires. Further, the Examiner's reliance upon column 15, lines 46 through 48 is also in error as this portion of the disclosure merely indicates that when messages are designated for a data-centric network the message is routed directly to the IP address of a recipient. However, figure 7 does not relate to a data-centric network but rather to a telephony centric network as evidenced by the use of the telephone number in the recipient field 712 thereof.

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Yet additionally, and contrary to the Examiner's assertions, HUNA does not at all disclose, in the claimed combination, an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. In other words according to the features of the present invention, the analyzer first obtains a telephone number from the received e-mail and, based upon the obtained telephone number, obtains the IP address from the memory within which the IP address is stored in association with the telephone number of the receiving IP apparatus.

Yet further, for receiving devices 520, 524, 528 connected to the telephony-centric network, a message router embeds a telephone number of a receiving device into the message, and routes the message to the IP address of "the local POP 408 (516)" corresponding to the embedded telephone number. Thus, the telephone number is utilized to route the message, in start contrast the claim recitations, where the IP address is utilized for this purpose, as recited in the last paragraph of claim 12.

Furthermore, upon the local POP 408 (516) receiving the message, the message intended for receiving devices connected to the telephony-centric network is transmitted via the telephony-centric network by the local switch 454. Thus, a transmitter in HUNA is not configured to transmit the received e-mail to the receiving IP address, based on an IP address of the receiving IP apparatus. Rather the message is transmitted to the receiving apparatus by telephone.

As discussed above, when messages designated for receiving devices connected to the data-centric network 406 are routed directly to the IP address of a receiving device,

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the message server 402 (514) merely translates the messages into formats compatible with the receiving devices. In other words, in such a case, the message server 402 (514) does not embed any telephone number of the receiving devices into the messages, and does not rely on any telephone number of the receiving devices to obtain the IP address of the receiving IP apparatus. On the other hand, for receiving devices connected to the telephony-centric network, the message server 402 (514) embeds the telephone number of a receiving device into the message along with contact protocol for the receiving device, and routes the message to the IP address of "the local POP 408 (516)" corresponding to the embedded telephone number. However, in this case, the message server 402 (514) embeds the telephone number of the receiving device into the message 534, and sends the message 534 to the IP address of "the local POP 408 (516)" (col. 16, line 53 - col. 17, line 31). Then, the local POP 408 (516) contacts the receiving device using the embedded telephone number (col. 17, lines 43-63). Thus, the local POP 408 (516) of the IP address is different from the receiving device 520, 524, 528 of the telephone number, which contradicts the explicit recitations of e.g. claim 12.

In either situation described in HUNA, the message server 402 (514) does not disclose the features recited in claim 12. That is, HUNA does not disclose at least a server apparatus that includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, "the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number".

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Further, HUNA does not disclose at least a server apparatus that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Thus, since HUNA does not disclose numerous of the recitations of claims 12 and 15-17, these pending claims are allowable over HUNA.

Therefore, the pending claims are clearly patentable over HUNA, at least for each and certainly for all of the above-noted reasons.

As set forth above, the rejection of independent claim 12 is improper and should be withdrawn. The rejection of independent claims 16 and 17 is also improper and should be withdrawn at least for reasons similar to those set forth above with respect to independent claim 12 insofar as claims 16 and 17 recite a system and a method including features generally similar to the features of the server apparatus recited in claim 12. Further, each of dependent claims 13-15 and 18 is allowable at least for depending, directly or indirectly, from an allowable independent claim, as well as for additional reasons related to their own recitations including those set forth below.

Regarding the rejection of claims 13 and 18 under U.S.C. § 103(a), HUNA does not disclose a server apparatus which includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number. HUNA also does not disclose a server that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

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RANALLI relates to an IP-PBX system that accepts a telephone number as a destination address, contacts a directory server, requests an IP address related to the telephone number and returns the IP address to the IP-PBX system (col. 7, lines 51-67 and col. 8, lines 1-18). However, RANALLI does not disclose at least the claimed analyzer, as defined in the pending claims. Rather, RANALLI merely teaches that an IP-PBX system contacts the directory server to request the IP address related to the telephone number and the IP address is returned to the IP-PBX system. Thus, RANALLI does not contain any disclosures regarding a server that includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus.

Further, RANALLI does not disclose at least a server that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Rather, in RANALLI the directory server merely returns the IP address to the IP-PBX system.

Thus, the pending claims are not disclosed, suggested or rendered obvious by RANALLI and HUNA, regardless of whether RANALLI discloses error notification. Moreover, the Office Action has not set forth any proper logical reasoning for the proposed combination aside from the unsupported assertion that HUNA and RANALLI are analogous art. In this regard, the required logical reasoning cannot merely consist of the mere assertion that two patents come from analogous fields.

Therefore, the rejection of claims 13 and 18 is improper for at least the reasons set forth above.

Regarding the rejection of claim 14 under U.S.C. § 103(a), GOODMAN relates to a system in which, when the sender's computer 920 sends a facsimile message to the

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recipient's facsimile machine 975, the facsimile message is sent from the sender's computer 920 to the sender's mail server 930. An address of the facsimile machine 975 includes a telephone number of the facsimile machine 975 and a domain name of the facsimile mail server 950. The sender's mail server 930 obtains an IP address of the facsimile mail server 950 from the DNS server 945, based on the domain name of the facsimile mail server 950. The sender's mail server 930 forwards the facsimile message to the facsimile mail server 950, based on the IP address of the facsimile mail server 950. The facsimile mail server 950 selects a gateway to which the facsimile message should be forwarded and forwards the facsimile message to the selected gateway. The gateway is selected based on loads on different gateways at a time when the facsimile communication is forwarded. Ultimately, the facsimile message is delivered from the selected gateway to the facsimile machine 975 over a conventional telephone network 970 (col. 6, lines 54-67 and col. 7, lines 1-33).

However, in GOODMAN, a telephone number is assigned to facsimile machine 975 (col. 6, lines 63-67), but an IP address is not assigned to the facsimile machine 975. The telephone number assigned to the facsimile machine 975 is a conventional telephone number (col. 6, lines 38-46). In other words, GOODMAN does not contain any disclosure regarding an IP address of the facsimile machine 975. Thus, in GOODMAN, a facsimile message is forwarded from the VOIP Outbound Gateway 956 to the facsimile machine 975 over the conventional telephone network 970, using the telephone number of the facsimile machine 975.

Further, an address, for example, 1112223333@faxservername.xxx, is utilized for forwarding a facsimile message to the facsimile machine 975. The address consists of the

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conventional telephone number of the facsimile machine 975 and a name of the facsimile mail server 950 (col. 6, lines 38-46 and col. 7, line 15). In other words, the address does not include an address of the VOIP Outbound Gateway 956. Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956.

Thus, GOODMAN does not disclose a H.323 gatekeeper which stores the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since GOODMAN does not contain any disclosure regarding an IP address of the facsimile machine 975 or a telephone number of the VOIP Outbound Gateway 956. GOODMAN also does not disclose an analyzer configured to determine whether the memory stores the IP address of the receiving IP apparatus. Further, GOODMAN does not disclose a transmitter which accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus when it is determined that the memory does not store the IP address of the receiving IP apparatus.

Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus.

Further, the Office Action has not set forth any proper basis or logical reasoning for the combination of the teachings of GOODMAN and HUNA. The mere assertion, even if true, that GOODMAN and HUNA are in analogous arts, does not in and of itself provide the logical reasoning required for a proper combination under 35 U.S.C. § 103.

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Therefore, the rejection of claim 14 is improper for at least the reasons set forth above.

Accordingly, as explained above, each of the claims now pending is allowable over the documents applied in the Office Action, whether these documents are considered alone or in any proper combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

By the present response, Applicants have submitted a number of new claims for consideration by the Examiner. Each of these claims is dependent from one of the shown to be allowable independent claims and is thus patentable at least based upon such dependence. Further, each of the above noted claims provides additional bases that distinguish the present invention from the disclosure of the references relied upon. Accordingly, Applicants respectfully request that the Examiner consider the newly submitted dependent claims and indicate the allowability thereof in due course, together with the allowability of the previously pending claims in the present application.

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SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have not amended any of the previously pending claims but have submitted a number of new dependent claims for consideration by the Examiner.

Applicants have discussed in detail, the disclosures of each of the references relied upon by the Examiner in the outstanding Official Action. Applicants have shown the inadequacy and insufficiency of the disclosures of the references relied upon by the Examiner with respect to the combinations of features recited in each of Applicants' independent claims. Applicants have addressed the specific recitations of Applicants' claims, that are not disclosed or rendered obvious by the references relied upon by the Examiner. Applicants have yet further noted the lack of any proper logical reasoning for the various combinations proposed and set forth by the Examiner in the outstanding Official Action. Accordingly, Applicants have provided a clear and convincing evidentiary basis supporting the patentability of all of the claims in the present application, including the newly submitted dependent claims.

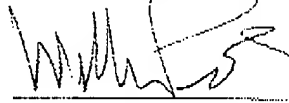
Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw each of the outstanding rejections applied against the previously pending claims, consider the newly submitted claims and provide an indication of the allowability of all the claims pending in the present application, in due course.

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The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any fees necessary to maintain the pendency of the above-identified application, including any extension of time fees to Deposit Account No. 19-0089.

Should there be any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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